UNITED STATES PATENT AND TRADEMARK OFFICE

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|---|---|---|---|
| 09/676,364 | 09/29/2000 | John D. Roper | MSFT-0207/150500.1 | 2193 |

7590          12/12/2003

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| EXAMINER |
|---|
| CAMPBELL, JOSHUA D |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2178 | |

DATE MAILED: 12/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

|  | Application No. | Applicant(s) |
|---|---|---|
| **Office Action Summary** | 09/676,364 | ROPER ET AL. |
|  | Examiner | Art Unit |
|  | Joshua D Campbell | 2178 |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE _3_ MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on _29 September 2000_.

2a)☐ This action is **FINAL**.     2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) _1-32_ is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) _1-32_ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on _29 September 2000_ is/are: a)☒ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All b)☐ Some * c)☐ None of:
   1.☐ Certified copies of the priority documents have been received.
   2.☐ Certified copies of the priority documents have been received in Application No. _____.
   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
   * See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

   a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
4)☐ Interview Summary (PTO-413) Paper No(s). _____.
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: .

U.S. Patent and Trademark Office
PTOL-326 (Rev. 11-03)                    Office Action Summary                    Part of Paper No. 4

## DETAILED ACTION

1.     This action is responsive to communications: Application filed on 09/29/2000.

2.     Claims 1-32 are pending in this case.  Claims 1, 12, and 23 are independent

claims.

### *Claim Rejections - 35 USC § 102*

3.     The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1-5, 12-16, and 23-26 are rejected under 35 U.S.C. 102(e) as being**

**anticipated by Kurtzman, II et al. (US Patent Number 6,144,944, filed on April 22,**

**1998).**

4.     **Regarding independent claim 1,**

   −   defining for each source of display items, a candidate set of items to be

       displayed;

          o   Kurtzman, II et al. discloses a method in which a set of advertisements

              (items) is selected to be considered for display (column 2, lines 25-38 of

              Kurtzman, II et al.);

- selecting display items from a pool of all candidate sets of display items, in a

    manner that normalizes the probability that the items of any one candidate set

    will be selected in relation to the items of the other candidate sets;

    o Kurtzman, II et al. disclose a method in which engines that process the

        sets can channel their results through each other, in order to find the best

        display items contained throughout all the sets, thus normalizing the

        selection process by giving all sets a chance (column 2, lines 38-47 of

        Kurtzman, II et al.); and

- inserting up to N of the selected items in the available display slots of the Web

    page;

    o Kurtzman, II et al. discloses a method in which the amount of

        advertisements requested is provided to complete the web page (column

        2, lines 25-38 of Kurtzman, II et al.).

5.    **Regarding dependent claim 2,**

- periodically repeating the steps;

    o Kurtzman, II et al. discloses a method in which the process is performed

        on any web page request (periodically) (column 2, lines 25-38 of

        Kurtzman, II et al.).

6.    **Regarding dependent claim 3,**

- defining a plurality of different levels of source participation, each source being

    associated with one level and each level having one or more sources associated

    with it;

- o Kurtzman, II et al. discloses a method in which the advertisements are divided into affinities (levels) (column 2, lines 25-38 of Kurtzman, II et al.);

- performing the steps separately for the sources at each level of participation, thereby selecting a number of display items at each level; and

  - o Kurtzman, II et al. discloses a method in which engines are used to operate on each affinity separately, thus obtaining the best results at each affinity (column 2, 25-47 of Kurtzman, II et al.); and

- selecting a predefined number of display items from said selected items at each level and assigning the predefined number of display items of each level to respective display slots on the Web page in a manner that gives preference to one level of source participation relative to another;

  - o Kurtzman, II et al. discloses a mehtod in which advertisements are selected from the criteria of each affinity, and then the web page is filled in with the advertisements in order of weightings (preference) of the different affinities (column 2, 25-47 of Kurtzman, II et al.).

7. **Regarding dependent claim 4,**

- assigning display slots that otherwise would have been assigned to the display items of that level instead to the display items at the highest other level of participation having available items to fill those slots;

  - o Kurtman, II et al. discloses a method in which if the highest preference affinity does not have enough items to cover the web pages needs the

next highest affinity is used to cover the needs (Figure 4 of Kurtzman, II et

al.).

8.      **Regarding dependent claim 5,**

–  filling the unfilled display slots with display items selected from sources outside of

said predefined levels of source participation;

> o  Kurtzman, II et al. discloses a method in which floating ads are used to fill
>
> in the display once there are no advertisements left in the predetermined
>
> affinities (column 23, lines 33-45 of Kurtzman, II et al.).

9.      **Regarding independent claim 12 and dependent claims 13-16,** the claims are

the medium containing instructions that correlates to the method of claims 1-5.  Thus,

the claims are rejected along the same rationale as claims 1-5

10.     **Regarding independent claim 23 and dependent claims 24-26,** the claims

incorporate substantially similar subject matter as claims 1 and 3-5.  Thus, the claims

are rejected along the same rationale as claims 1 and 3-5.


*Claim Rejections - 35 USC § 103*

11.     The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

12.     This application currently names joint inventors.  In considering patentability of

the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation

under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to

consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g)

prior art under 35 U.S.C. 103(a).


**Claims 6-11, 17-22, and 27-32 are rejected under 35 U.S.C. 103(a) as being**

**unpatentable over Kurtzman, II et al. (US Patent Number 6,144,944, filed on April**

**22, 1998) as applied to claims 1, 7, 12, 18, 23, and 28 above, and further in view of**

**Langheinrich et al. (US Patent Number 6,654,725, filed on November 9, 1999).**

13.    **Regarding dependent claim 6,**

- weighting the items in each candidate set to normalize the probability that items

   from any one candidate set will be selected from the pool of all candidate sets,

   thereby providing a normalized pool of candidate sets;

   o   Kurtzman, II et al. disclose a method in which engines that process the

      weighted advertisement sets can channel their results through each other,

      in order to find the best display items contained throughout all the sets,

      thus normalizing the selection process by giving all sets a chance (column

      2, lines 38-47 of Kurtzman, II et al.); and

- randomly selecting said items from the normalized pool of candidate sets;

> o   Kurtzman, II et al. does not disclose randomly selecting an item from the
>     overall set.  However, Langheinrich et al. discloses a method in which an
>     advertisement is randomly selected based on assigned weightings
>     (column 8, lines 1-18 of Langheinrich et al.).  It would have been obvious
>     to one of ordinary skill in the art at the time the invention was made to
>     have combined the method of Kurtzman, II et al. with the method of
>     Langheinrich et al. because it would have been more flexible by
>     normalizing the selection process (bring the probability to 1.0).

14.   **Regarding dependent claim 7,**

– Randomly selecting one of the candidate sets;

– selecting one item from the selected candidate set;

> o   Kurtzman, II et al. discloses a method in which an advertisement is
>     selected from a list generated from a set (column 2, lines 38-47 of
>     Kurtzman, II et al);

– reducing a count of the display items of the selected candidate set by one and
  removing that candidate set from further consideration when the count reaches
  zero;

> o   Kurtzman, II et al. discloses a method advertisements are selected from a
>     set and removed from consideration by decrementing a reference counter
>     (column 14, lines 21-end of page of Kurtzman, II et al.), and once a set
>     contains no items the set is removed from consideration and the next set
>     is considered (Figure 4 of Kurtzman, II et al.); and

- repeating the steps until a desired number of display items have been selected;

  o Kurtzman, II et al. discloses a method in which the amount of advertisements requested are provided to complete the web page (column 2, lines 25-38 of Kurtzman, II et al.).

  o Kurtzman, II et al. does not disclose randomly selected a candidate set. Langheinrich et al. discloses a method a selection of advertisements is made randomly (column 8, lines 1-18 of Langheinrich et al.). Langheinrich et al. also discloses that it would increase performance to make selections by group rather that single advertisements (column 3, lines 33-36 of Langheinrich et al.). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of Kurtzman, II et al. with the method of Langheinrich et al. because it would have been more flexible by normalizing the selection process (bring the probability to 1.0).

15. **Regarding dependent claims 8 and 9,**

- randomly selecting one item from the selected candidate set; and

- selecting one item from the selected candidate set in accordance with a weighting of items applied to the selected candidate set;

  o Kurtzman, II et al. does not disclose randomly selecting an item from a set based on weighting. However, Langheinrich et al. discloses a method in which an advertisement is randomly selected from a set based on assigned weightings (column 8, lines 1-18 of Langheinrich et al.). It would

have been obvious to one of ordinary skill in the art at the time the

invention was made to have combined the method of Kurtzman, II et al.

with the method of Langheinrich et al. because it would have been more

flexible by normalizing the selection process (bring the probability to 1.0).

16. **Regarding dependent claim 10,**

− defining, for each source of display items, a candidate set of items to be

displayed, each candidate set of items having at least a first subset and a second

subset, each subset having a count associated therewith of the number of

display items in that subset, and wherein the steps are performed first on the first

subset of display items until the count for that subset reaches zero, and then on

the second subset; and

− the candidate set being removed from further consideration only after the counts

of both subsets reach zero

       o Kurtzman, II et al. discloses a method in which a set is broken down into

multiple affinities (subsets) (column 2, lines 25-38 of Kurtzman, II et al.).

Kurtzman, II et al. discloses a method advertisements are selected from

an affinity set and removed from consideration by decrementing a

reference counter (column 14, lines 21-end of page of Kurtzman, II et al.),

and once an affinity set contains no items the set is removed from

consideration and the next affinity set is considered (Figure 4 of Kurtzman,

II et al.).

17. **Regarding dependent claim 11,**

– two or more subsets, and wherein the steps are performed, in turn, on each

successive subset until the counts of all of the subsets reach zero;

    o Kurtzman, II et al. discloses a method in which a set is broken down into

    multiple affinities (subsets) (column 2, lines 25-38 of Kurtzman, II et al.).

    Kurtzman, II et al. discloses a method advertisements are selected from

    an affinity set and removed from consideration by decrementing a

    reference counter (column 14, lines 21-end of page of Kurtzman, II et al.),

    and once an affinity set contains no items the set is removed from

    consideration and the next affinity set is considered, and then the next,

    and so on (Figure 4 of Kurtzman, II et al.).

18.    **Regarding dependent claims 17-22,** the claims are the medium containing

instructions that correlates to the method of claims 6-11. Thus, the claims are rejected

along the same rationale as claims 6-11.

19.    **Regarding dependent claims 27-32,** the claims incorporate substantially similar

subject matter as claims 6-11. Thus, the claims are rejected along the same rationale

as claims 6-11.

### Conclusion

20.    The prior art made of record and not relied upon is considered pertinent to

applicant's disclosure.

    **US Patent Number 5,959,623 – van Hoff et al.**

    **US Patent Number 6,128,663 – Thomas**

**US Patent Number 6,604,085 – Kolls**

**US Patent Application Publication Number 2002/0010753 – Matsuoka et al.**

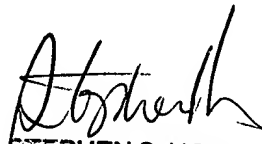**US Patent Application Publication Number 2002/0013174 – Murata**

**US Patent Application Publication Number 2002/0077889 – Kolls**


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua D Campbell whose telephone number is (703)305-5764. The examiner can normally be reached on M-F (8:00 AM - 4:30 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (703)308-5186. The fax phone number for the organization where this application or proceeding is assigned is (703)746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

jdc
November 3, 20003

STEPHEN S. HONG
PRIMARY EXAMINER